

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-19 are now present in this application. Claims 1, 7, 13 and 18 are independent. By this amendment, claims 1, 7, 13 and 18 are amended. No new matter is involved.

Reconsideration of this application is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document from WIPO/IB.

Information Disclosure Citation

Applicant thanks the Examiner for providing an initialed copy of the PTO/SB/08a/b filed with the Information Disclosure Statement (IDS) December 15, 2004.

Entry of Amendments

Applicant respectfully submits that it is proper to enter the amendments to claims 1, 7, 13 and 18 because they merely clarify that by the back side of the rotor is the upper side of the rotor. As a result, the amendment will not require further consideration and/or search.

Rejections under 35 U.S.C. § 103

Claims 1-11, 18 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP-14028570 in view of U.S. Patent 6,765,331 to Koyanagi. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. §103, " [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re

O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d

1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory

statements of the Examiner. See, *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Claims 1, 7 and 18, as amended, clearly patentably define over the applied art. None of the three applied references disclose the positively recited features of claims 1-11, 18 and 19. Claims 1 and 7 recite a combination of features including a rotator in which the coil is placed that covers all of the back side and outer, upper circumference of the coil, and claim 18 recites a combination of features including a rotator placed upon a circumference of the rotational shaft to accept a coil so that all of the back side and outer, upper circumference of the coil are covered with the rotator. None of the applied references discloses or suggests such combinations of features. In this regard, the Office Action effectively admits that such features are not disclosed by the applied Japanese Published patent applications (JP '570).

The Office Action states that JP '570 discloses, in Figs. 2, 5, 6 and 8-11 that the rotator (R) has a resin/insulating molded base (9 in Fig. 2, or 28 of Figs. 5, 6 and 8-11) that covers all the back side and outer circumference of the coils (8 in Fig. 2 or 27 of Figs 5, 6 and 8-11).

Applicant respectfully disagrees. All that JP '570 discloses in this regard is a rotor base 1 that clearly does not cover the outer circumference of coil 2. In fact, as shown in Figs. 2 and 5-7, the outer circumference of coil 2 is completely uncovered.

Apparently realizing this, the Office Action takes Official Notice that the practice of protecting the coils by molding to cover all of the coil's sides is well known in the art and references three patents in this regard. This use of three alternative secondary references is completely contrary to the express requirement in MPEP §§706.02(I) and 904.03 for the Examiner to select and apply only the best reference in rejecting the pending claims. The outstanding Office Action does not do this, however. Instead, it cites and applies, individually, three different references, all under the same statute, i.e., 35 USC §103(a). For this reason alone, the rejection is improper and must be withdrawn.

Moreover, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention by completely failing to allege, let alone provide objective factual evidence that explains why one of ordinary skill in the

art would be properly motivated to modify JP '570 to provide a rotor inserted onto the rotational shaft to rotate and formed of a resin base wherein the rotator in which the coils are placed covers all of the back/upper side and outer circumference of the coil, as claimed.

JP '570 apparently works well in its present configuration. Moreover, the Examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc., 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987) and In re Kamm, 452 F.2d 1052, 1057, 172 USPQ 298, 301-2 (CCPA 1972), and obviousness cannot be established by locating references which describe various aspects of appellant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what appellants have done. Ex parte Levengood, 28 USPQ2d 1300, 1302 (Bd. App. & Int. 1993). Here the Office Action fails to present any persuasive evidence of such a motivating force.

Furthermore, with respect to An, the back side of An's winding coil 27 is open, as clearly shown in Figs. 4-11, so even if An were properly used to modify JP '570, the resulting modification of JP '570 would not meet or render obvious, the claimed invention.

Moreover, with respect to Hayashi, Hayashi's coils 33 are not rotor coils, but stator coils, and the stator coils are formed into a single block to avoid turbulent flows (col. 6, lines 15-26), which are necessarily going to occur in JP '507 because of the eccentric element in the rotator of JP '507 that causes vibration of the motor. In other words, JP '507 teaches away from having its rotor coils (not stator coils, as in Hayashi) formed into a single block to achieve laminar flow. Applicant respectfully submits that one of ordinary skill in the art would not be motivated to look to Hayashi's stator coils that achieve laminar flow to modify JP '507, as suggested, because these references teach away from being combined, as suggested.

With respect to Fujii, Applicant respectfully submits that the Office Action has not established by objective factual evidence that one of ordinary skill in the art would be motivated to turn to Fujii to modify JP '507, as suggested, because a fundamental feature of Fujii is to have coils around the entire circumference of the rotor, including under weight 24, whereas a fundamental feature of JP '507 is to have coils on only one portion of the rotor and a weight on only the remaining portion of the rotor. Because of this, the Office Action has not provided objective factual evidence that one of ordinary skill in the art would be properly motivated to turn to Fujii to modify JP '570.

The Office Action then turns to Koyanagi to modify JP '570 to provide a coil having an upper end that is positioned lower than an upper end of the

rotator. However, as pointed out in the response to the previous Office Action, even if it were obvious to modify JP '570 as suggested, the modified version of JP '570 would neither meet nor render obvious the claimed invention because the rotor R disclosed in Koyanagi's Fig. 7, which forms the basis for the rejection of these claims, has a rotor base 1 that does not cover all of the top and sides of the coils, as recited.

Additionally, JP '570's rotator (r) does not cover the upper surface of the coil 27, as is apparent from an inspection of Figs. 4 and 5 of JP '570.

Moreover, as pointed out above, a showing of a suggestion, teaching, or motivation to combine the prior art references, which is an "essential evidentiary component of an obviousness holding," must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See *In re Dembicza*k, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Unfortunately, the "Official Notice" is only a broad, conclusionary statement about multiple references (three references being cited in this instance) that is not the clear and particular factual evidentiary component that constitutes evidence of proper motivation to modify JP '507, as suggested.

Accordingly, reconsideration and withdrawal of this rejection of claims 1-11, 18 and 19 are respectfully requested.

Claim 12 stands rejected under 35 U.S.C. §103(a) as unpatentable over the art applied in the rejection of claim 7 (from which claim 12 depends) in view of U.S. Patent 6,359,364 to Yamaguchi et al. ("Yamaguchi"). This rejection is respectfully traversed.

Initially, Applicant notes that claim 7, from which claim 12 depends, patentably defines over the art applied in the rejection of claim 7, for reasons stated above. Moreover, Yamaguchi is not being applied to remedy the deficiencies noted above with respect to the art applied in the rejection of claim 7.

Accordingly, even if it were obvious to modify the art applied in the rejection of claim 7, the resulting modified version of that art would neither disclose or suggest the invention recited in claim 12.

Reconsideration and withdrawal of this rejection of claim 12 are respectfully requested.

Claims 13-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP-14028570 in view of Koyanagi and Yamaguchi. This rejection is respectfully traversed.

Complete discussions of the Examiner's rejections are set forth in the Office Action, and are not being repeated here.

Claims 13-17, as amended, clearly patentably define over the applied art. None of the four applied references disclose the positively recited features of claims 13-17. Independent claim 13 recites a combination of features including a rotator inserted onto the rotational shaft and formed of base made of resin, for rotating, that covers all of the back side and outer, upper circumference of the coil.

None of the applied references disclose or suggest such a combination of features. In this regard, the Office Action effectively admits that such features are not disclosed by either of the two applied Japanese published patent applications (JP '570 or JP '804), or by Yamaguchi.

Additionally, the rotor R disclosed in Koyanagi's Fig. 7, which forms part of the basis for the rejection of these claims, has a rotor base 1 that does not cover all of the top and sides of the coils, as recited.

Accordingly, even if it were obvious to modify either of the applied Japanese patent publications in view of the secondary references to Koyanagi and Yamaguchi, the resulting modified version of either one would neither disclose nor suggest the claimed invention.

Reconsideration and withdrawal of this rejection of claims 13-17 are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

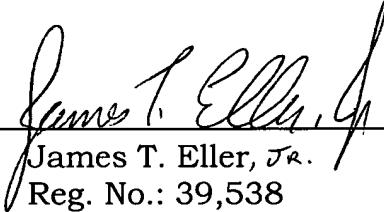
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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